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10/593,826	10/27/2006	Keiichi Matsushashi	0670-7086	4457
31780	7590	12/03/2008	EXAMINER	
ERIC ROBINSON			SIVJI, NIZAR N	
PMB 955			ART UNIT	
21010 SOUTHBANK ST.			PAPER NUMBER	
POTOMAC FALLS, VA 20165			4172	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/593,826

Applicant(s)

MATSUHASHI, KEIICHI

Examiner

NIZAR SIVJI

Art Unit

4172

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-11 is/are pending in the application.
4a) Of the above claim(s) is/are withdrawn from consideration.
5) ☐ Claim(s) is/are allowed.
6) ☒ Claim(s) 8-11 is/are rejected.
7) ☐ Claim(s) is/are objected to.
8) ☐ Claim(s) are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 22 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. .
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-85/86)
Paper No(s)/Mail Date 9/22/2006, 2/21/2007
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date
5) ☐ Notice of Informal Patent Application
6) ☐ Other:

DETAILED ACTION

Status of the Claims

1. Claim 1 – 7 has been cancelled
2. Claim 8 – 11 are currently pending in this application.

Specification

Paragraph 67: The transceiver 24-k should be connected to the network T.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2173.05(p) Claim Directed to Product-By- Process or Product and Process

II. PRODUCT AND PROCESS IN THE SAME CLAIM

A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. In *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990), a claim directed to an automatic transmission workstand and the method steps of using it was held to be ambiguous and properly rejected under 35 U.S.C. 112, second paragraph. Such claims should also be rejected under 35 U.S.C. 101 based on the theory that the claim is directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. *Id.* at 1551.

2. Claims 8 – 11 are rejected under 35 U.S.C. 101 because the claimed invention is drawn to more than one statutory class.

Claim Rejections - 35 USC § 112

3. Claim 8 – 11 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

Evidence that claim 8 - 11 fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found in the reply filed October 27, 2006. In that paper, applicant has stated apparatus and the method steps in single claim which according to MPEP 2173.05 as mentioned above and should be rejected since it is neither a process nor a machine, and this statement indicates that the invention is different from what is defined in the claim(s) because applicant is claiming system and method in the same claim.

Claim 8 recites both structure and method in the same claim. For example

- "A service class control system comprising (Structure)
 - o Mean for storing
 - o Mean for retrieving"
- and then claim terminal device (Method)
 - o obtain the retrieved service class data indicative of the range of service
 - o transmit the service class data stored
- and then claim service class control server
 - o retrieves from the mean of storing

Claim 9 recites both structure and method in the same claim. For example

- "A service class control system comprising (Structure)
 - o Mean for storing
 - o Mean for retrieving"
- and then claim terminal device (Method)
 - o obtain and restore the retrieved service class data

- and then claim service class control server
 - o retrieves from the mean of storing

Claim 11 recites both structure and method in the same claim. For example

- A terminal device (Structure)
 - o Mean for storing
 - o Mean for retrieving"
- and then claim terminal device (Method)
 - o obtain and restore the retrieved service class data
 - o transmit the service class data stored
- service class control server
 - o retrieves from the mean of storing

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 8 – 11 are rejected under 35 U.S.C. 102(b) as being anticipated by

Haumont Pub No. US 2003/0027554 A1

As Per Claim 8: Haumont teaches a service class control system comprising a service class control server and a plurality of terminal devices connected to the service class control server via a wireless telephone network(i.e., mobile terminal connected to the network Para 22);

characterized in that the service class control server comprises:

means for storing, for each terminal device, service class data indicative of a range of service served by the terminal device(i.e., subscriber information and service stored in the network switch Para 23, 27); and

means for retrieving, from the means for storing, a service class data associated with an identification data for identifying the terminal device and for transmitting the retrieved service class data to the terminal device as a data indicative of a range of service which the terminal device can serve, in response to the identification data which is received from the terminal device and identifies the terminal device(i.e., storing subscriber information including terminal device with applicable service which terminal device can serve Para 27-28), when the terminal device requires a start of providing a service; and wherein the terminal device: obtains and stores the retrieved service class data indicative of the range of service which the terminal device itself can serve, when the terminal device receives the retrieved service class data from the service class control server, and provides services lying within the range indicated by the stored service class data(i.e., storing device including a SIM card that can hold subscriber identity, perform authentication algorithms, and stores authentication and encryption key and some subscription information that is needed in the mobile station Para 22),; and transmits the service class data stored in the terminal device and the identification data for identifying the terminal device to the service class control

server in response to reception of an interrogation signal via the wireless telephone network (mobile node that has a radio interface to the network Para 22); and

wherein the service class control server:

retrieves, from the means for storing, a service class data associated with the identification data which the terminal device has transmitted in response to reception of the interrogation signal (terminal identification and authentication Para 18), and verifies match among the retrieved service class data and the service class data which the terminal device has transmitted in response to reception of the interrogation signal (i.e., Mobile node which support packet data transmission and has a radio interference to the network and can store subscriber information Para 22).

As Per Claim 9: Haumont teaches a service class control server for use in a service class control system comprising the service class control server and a plurality of terminal devices connected to the service class control server via a wireless telephone network (i.e., mobile terminal connected to the network Para 22);

said service class control server comprises:

means for storing, for each terminal device, service class data indicative of a range of service served by the terminal device (i.e., subscriber information and service stored in the network switch Para 23, 27); and

means for retrieving, from the means for storing, a service class data associated

with an identification data for identifying the terminal device (terminal identification and authentication Para 18), and for transmitting the retrieved service class data to the terminal device as a data indicative of a range of service which the terminal device can serve, in response to the identification data which is received from the terminal device and identifies the terminal device (i.e., storing subscriber information including terminal device with applicable service which terminal device can serve Para 27-28), when the terminal device requires a start of providing a service; and wherein the terminal device: obtains and stores the retrieved service class data indicative of the range of service which the terminal device itself can serve, when the terminal device receives the retrieved service class data from the service class control server, and provides services lying within the range indicated by the stored service class data (i.e., storing device including a SIM card that can hold subscriber identity, perform authentication algorithms, and stores authentication and encryption key and some subscription information that is needed in the mobile station to authenticate service Para 22); and wherein the service class control server: retrieves, from the means for storing, a service class data associated with the identification data which the terminal device has transmitted to the service control server in response to reception of an interrogation signal via the wireless telephone network, and verifies match among the retrieved service class data and the service class data

(i.e., identify terminal device and mobile node to transmit data to the network via radio network interface Para 18, 22) which the terminal device has transmitted in response to reception of the interrogation signal via the wireless telephone network signal (i.e., Mobile node which support packet data transmission and has a radio interference to the network and can store subscriber information Para 22).

As Per Claim 10: Haumont teaches the service class control server as set forth in Claim 9 as mentioned above, wherein the service class control server transmits service stop instruction data to the terminal device when the service class control server can verify no match among the retrieved service class data and the service class data which the terminal device has transmitted (i.e., In response to message HLR sends a modification request in order to modify data in SGSN. SGSN notices change in service that an inactive PDP context was activated with the subscription information which is not valid and trigger the deactivation request Para 44).

As Per Claim 11: Haumont teaches a terminal device for use in a service class control system comprising a service class control server and a plurality of terminal devices connected to the service class control server via a wireless telephone network, said service class control server comprises(i.e., mobile terminal connected to the network Para 22):
means for storing, for each terminal device, service class data indicative of a range of service served by the terminal device (i.e., subscriber information and

service stored in the network switch Para 23, 27); and means for retrieving, from the means for storing, a service class data associated with an identification data for identifying the terminal device(i.e., terminal identification and authentication Para 18), and for transmitting the retrieved service class data to the terminal device as a data indicative of a range of service which the terminal device can serve, in response to the identification data which is received from the terminal device and identifies the terminal device(i.e., storing subscriber information including terminal device with applicable service which terminal device can serve Para 27-28), when the terminal device requires a start of providing a service; wherein the terminal device: obtains and stores the retrieved service class data indicative of the range of service which the terminal device itself can serve, when the terminal device receives the retrieved service class data from the service class control server, and provides services lying within the range indicated by the stored service class data (i.e., storing device including a SIM card that can hold subscriber identity, perform authentication algorithms, and stores authentication and encryption key and some subscription information that is needed in the mobile station to authenticate service Para 22); and transmits the service class data stored in the terminal device and the identification data for identifying the terminal device to the service class control server in response to reception of an interrogation signal via the wireless telephone network(i.e., identify terminal device and mobile node

to transmit data to the network via radio network interface; and wherein the service class control server: retrieves, from the means for storing, a service class data associated with the identification data which the terminal device has transmitted in response to reception of the interrogation signal, and verifies match among the retrieved service class data and the service class data which the terminal device has transmitted in response to reception of the interrogation signal (identifying the terminal device and match service data for the service node to provide service to the subscriber Para 18, 19).

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NIZAR SIVJI whose telephone number is (571)270-7462. The examiner can normally be reached on Mon - Fri 8:00AM - 5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lewis West can be reached on 5712727859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/NIZAR SIVJI/
Examiner, Art Unit 4172

/Lewis G. West/
Supervisory Patent Examiner, Art Unit 4172